

ESTTA Tracking number: **ESTTA705698**

Filing date: **10/30/2015**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91217760
Party	Plaintiff Peristyle, LLC
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Date	10/30/2015
Attachments	Motion to Suspend as a result of District Court Action.pdf(17986 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of
Application Nos. 86/122,346; 86/122,347; 86/122,348; 86/122,349; and 86/122,350
For the Trademark OLD TAYLOR
Published April 15, 2014

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PERISTYLE, LLC)	
)	
Opposer,)	
)	
v.)	Opposition No.91217760
)	
SAZERAC NORTH AMERICA, INC.,)	
)	
Applicant)	
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OPPOSER’S MOTION TO SUSPEND

Opposer brings this Motion to Suspend as a result of Applicant’s action filed in the U.S. District Court for the Eastern District of Kentucky filed against Opposer on October 27, 2015, and served upon Opposer on October 30, 2015, and a related entity to Opposer. Pursuant to 37 CFR §2.117(a), Opposer requests that the Opposition be suspended pending disposition of the action filed in the U.S. District Court for the Eastern District of Kentucky. A copy of the Complaint in Case No. 3:15-cv-00076 is attached hereto as Exhibit A.

Applicant filed a Complaint against Opposer in U.S. District Court for the Eastern District of Kentucky, alleging Opposer is infringing Applicant’s trademarks, including its trademarks for the mark OLD TAYLOR, which are the subject of the Trademark Applications in the instant Opposition Proceeding (Application Serial Nos. 86/122,346; 86/122,347; 86/122,348; 86/122,349; and 86/122,350). In the Complaint, Applicant alleges Opposer infringed it’s mark as a result of one entertainment event hosted at Opposer’s property by a third party event-hosting

business, and because the name “Old Taylor Distillery” has been used in several media reports related to the property.

Applicant has filed the subject Applications in this Opposition in connection with the following uses:

Applicant filed an intent-to-use application under Section 1(b) of the Trademark Act for the mark OLD TAYLOR in International Class 15 for use with various printed educational materials in the field of whiskey, the history of whiskey, and for use in related tourism industries.

Applicant also filed the Mark in International Class 35 for use with “promoting, marketing and fostering travel and tourism in the United States, namely, providing destination advertising services; marketing advertising and promoting goods and services of others in the field of American whiskey production, bottling, and distribution; online retail gift shops; promotional sponsorship of county and state fairs and community festivals and sporting, equestrian and athletic events; providing information via a website in the field of business information regarding whiskey distilleries; association services, namely, promoting the interests of the bourbon industry.”

Applicant filed an intent-to-use application under Section 1(b) of the Trademark Act for the mark OLD TAYLOR in International Class 39, in connection with “Providing travel and transportation information services via a global information network; organizing and operating travel tours related to the history of American whiskey and the production, bottling, and distribution of whiskey”.

Applicant filed an intent-to-use application under Section 1(b) of the Trademark Act for the mark OLD TAYLOR in International Class 40, in connection with “providing a destination web site for the provision of education information regarding whiskey distilleries”.

Applicant filed an intent-to-use application under Section 1(b) of the Trademark Act for the mark OLD TAYLOR in International Class 41, in connection with “educational services, namely, conducting classes and seminars in the field of whiskey; arranging and conducting special social events related to the whiskey industry for social entertainment purposes; providing private guided tours of museums, historical sites, and geographic points of interest; organizing social events, namely, whiskey tastings and food tastings; providing a destination web site for the provision of educational information regarding the history of American whiskey”.

In its Opposition, the Opposer alleged that Applicant’s Trademark Applications should be refused registration on the grounds that they are geographically misdescriptive. Opposer posits that the name “OLD TAYLOR” so commonly refers to the location of the property owned by Opposer that Applicant’s use of the trademark in connection with the services in the Applications opposed herein is geographically misdescriptive. Opposer is preparing an Answer and Counterclaim in the pending District Court action including Counterclaims addressing the same issues regarding the geographic descriptiveness of the OLD TAYLOR name raised in this Opposition.

Both the pending Opposition and District Court actions involve common issues of fact and law. Both matters involve Applicant’s alleged rights to the trademark OLD TAYLOR, and Opposer’s allegations that the Applicant’s use of the goods and services claimed in the underlying Applications is geographically misdescriptive. For both parties, the factual evidence required to prove these issues will be the same for both the Opposition, and the District Court proceeding.

As a result, Opposer believes it is appropriate to suspend the Opposition pending disposition of the U.S. District Court case. A suspension of the Opposition will reduce

duplicative efforts for the parties, as well as eliminate potential unnecessary efforts for the Board. In the interest of judicial efficiency, the Opposer respectfully requests the Board enter its Motion to Suspend pending the outcome of pending U.S. District Court Case No. 3:15-cv-00076.

Respectfully Submitted,

Date: October 30, 2015

/todd e stockwell/

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that on the 30th day of October, 2015, a true and correct copy of the foregoing Motion to Suspend was served by regular U.S. mail, with a copy by email, upon the following counsel for Applicant:

Todd S. Bontemps, Esq.
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By: /todd e stockwell/

Todd E. Stockwell